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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,162	03/09/2004	James D. Welch		3028

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JAMES D. WELCH
10328 PINEHURST AVE.
OMAHA, NE 68124

EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/796,162	WELCH, JAMES D.	
	Examiner	Art Unit	
	Robert M. Pond	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22, 23 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Applicant amended claims 1, 12, 19, and 23 and newly added claims 25-27. All pending claims 1-27 were examined in this final office action necessitated by amendment to claim 23 and newly added claims.

The Applicant is reminded that twice-rejected claims are eligible for appeal.

Response to Arguments

Applicant's arguments filed 22 and 23 January 2007 have been fully considered but they are not persuasive. The Applicant amended claims to overcome prior art Allison and based arguments on the amended claim language. This Examiner respectfully disagrees with the Applicant's interpretation of Allison. Allison does not require the learner to take a competency test first before taking a course. As depicted in Figure 5, a user may take a competency test and have online courses recommended for future use but there is clearly another option and that is to take a course (see Fig. 5 (184); col. 9, lines 17-37) without having to take a competency test. If the Applicant's interpretation of Figure 5 is correct, then the learner would have to take a competency test first before reviewing News & Events (see Fig. 5 (180); col. 9, lines 17-37). If a competency test is taken, clicking on the improvement icon 220 of Fig. 7 leads to Fig. 8. which identifies recommended course(s) for improvement in particular

areas. Figure 8 is not the web page that would be displayed by clicking on icon 184. The user can click on icon 184 and go directly to courses without having to take a competency test first.

Regarding motivation to combine, Allison specifically teaches the need for keeping professionals up-to-date. and teaches the use of audio tapes for training. Though not relied upon, one of ordinary skill in the art would find updating courseware being fundamental to providing a competitive continuing education service in science and technology-based fields, medical, legal, etc. It is neither novel nor non-obvious to update courses in an attempt to keep pace with these rapidly changing fields of endeavors. Lawcast closes gaps in Allison in terms of updating courseware content. Lawcast provides teachings pertinent to the field of continuing education and its use as a secondary reference to modify Allison has nothing to do with the delivery medium. The Applicant admits to having subscribed to Lawcast since about 1993 (Discussion, page 22) so the Applicant has been a user of audio delivered continuing education which is the thrust of the Applicant's invention. The Internet is another delivery medium for audio content to users and keeping professional up-to-date by updating courseware is prudent business practice.

Allison specifically teaches as prior art the use of audio tapes for training and proceeds to describe improvements over the prior art. Lawcast provides an excellent modifying reference for business methods practices using audio tapes for training and continuing education and updating such items. Allison and

Lawcast are in the same field of endeavor, both are attempting to solve the same top-level problem-delivering continuing education with a user-convenient delivery medium (i.e. computer network, tapes), and both are dealing with keeping customers up-to-date in their profession. The combination of Allison and Lawcast is proper.

Although not relied upon, Darago (US 6,170,014) with an effective filing date of 18 March 1999 provides significant teachings pertaining to the state of the art at time of filing. Providing continuing education using the Internet or other networks communication means was well-known at the time and distributing content in audio formats was likewise known at the time.

Admitted Prior Art- Official Notice (ON1 and ON2)

The Applicant did not traverse the examiner's assertions of official notice. The common knowledge or well-known in the art statements are taken to be admitted prior art because applicant failed to traverse or adequately traverse the examiner's assertion of official notice (MPEP 2144.03(C)).

Affidavits/Declarations

The attestation filed on 22 January 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Allison patent reference.

The Applicant's declaration fails to meet the requirements set forth under 37 CFR 1.131. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Allison reference. While conception

is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Allison reference to either a constructive reduction to practice or an actual reduction to practice. The Applicant admits to lacking diligence from a date prior to the date of reduction to practice by claiming he was too busy to proceed. Demonstration of diligence is required to perfect a declaration under Rule 131. Based on Applicant's admission, the Applicant cannot perfect a declaration under Rule 131 to overcome prior art Allison.

Please note the Applicant must include with any declaration under Rule 131 an acknowledgement that willful false statements are punishable by fine or imprisonment, and may jeopardize the validity of the application.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

- 1. Claims 1-7, 9, 10, 15, 21, 25, are rejected under 35 USC 103(a) as being unpatentable over Allison (IDS entered 09 March 2004, US 6,546,230) in view of Lawcast (a collection of prior art disclosing Lawcast cited in PTO-892, Items: U and V).**

Allison teaches a system and method of providing continuing education and learning assessment via an Internet web site (see at least abstract; Fig. 1; col. 1, line 5 through col. 2, lines 42). Allison further teaches:

- *an information provider providing an internet web site;* (see at least Fig. 1 (24, 80, 84); col. 2, line 1-23; col. 5, lines 14-29).
- *said information provider making audio format professional continuing education information available from audio information format machine readable storage via said web site, in topical categories;* system provides topical information in audio format (see at least Fig. 8; col. 2, lines 24-42; col. 5, lines 47-52; col. 10, lines 46-50); audio format, either online or via audio tape, CR-ROM, or live broadcast seminar (see at least col. 8, lines 18-22; col. 10, lines 59-67).
- *making access to said audio format professional continuing education information available, via said web site to clients by a selection from the*

group consisting of: periodic subscription; direct pay per access event; access granted on subscription basis, pay-per-use, one time fee (see at least col. 6, lines 54-65).

- said information provider allowing at least one client to receive said audio format professional continuing education information via said web site by, using an internet accessing means, accessing said web site, and providing payment via a selection from the group consisting of: proof of paid subscription; and presenting payment means; Inherent in Allison are the structures necessary to permit providing payment. For example, Allison teaches a network connectivity module being coupled to a license module for verifying subscriber status or pay-per-use access (see at least col. 6, lines 54-65). To become access the system one must have paid.
- and identifying a professional continuing education information topical category of interest, followed by said at least one paying client receiving audio format professional continuing education information in said topical category of interest; user selects course and receives in audio format (see at least Fig. 8; col. 10, lines 46-67).
- attestation; see at least Fig. 5 (182); Fig. 6 (202); Fig. 7 (204); abstract; col. 10, lines 16-45).
- linkage to state licensing body; submits user's transcripts to state licensing entity or other certifying organization(see at least Fig. 9; col. 2, lines 38-42; col. 11, lines 26-33).

- live audio presentation: live broadcast seminar (see at least col. 8, lines 18-22; col. 10, lines 59-67).
- other sources: (see at least col. 5, lines 44-52).
- Overcoming deficiencies: recommends other courses to overcome deficiencies (see at least Fig. 7 (204, 216, 218) and supporting disclosures).
- database storage: stores user profile and records (see at least Fig. 11 (286, 294) and supporting disclosures)

Allison teaches all the above as noted under the 103(a) rejection and teaches a) providing technological improvements over existing audio tape-based services in delivering continuing education coursework using the Internet and World Wide Web in audio format, b) providing news and recent additions to the site (see at least Fig. 5), and further teaches the importance of professionals (e.g. medical practitioners) staying up to date in their practice (see at least col. 1, lines 13-17), yet does not disclose updating the audio format in the at least one client identified topical category. On the other hand, Lawcast teaches a system and method of audio format delivery via tape cassettes to legal professionals on the go who want to stay up to date of topics of interest by listening to audio tapes while doing other tasks (e.g. driving a car). Lawcast teaches the subscription-based service providing a 60 to 90-minute tape every two weeks including an outline (i.e. summary) (please note examiner's interpretation: a new tape every two weeks since it doesn't make good business sense to ship the same tape

every two weeks to the same individual within the context of staying up to date in the changing legal profession). Lawcast further teaches providing the subscriber with a printed outline that summarizes and cites every case, story, and authority mentioned on tape (U: see at least pages 1 and 2; V: see page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Allison to update the audio format and include case digests and summaries as taught by Lawcast, in order to keep the subscriber up to date in the practice, and thereby attract subscribers to the online service.

- 2. Claim 8 is rejected under 35 USC 103(a) as being unpatentable over Allison (IDS entered 09 March 2004, US 6,546,230) and Lawcast (a collection of prior art disclosing Lawcast cited in PTO-892, Items: U and V), as applied to claim 1, further in view of ON1 (admitted prior art, Official Notice regarding notoriously old and well known in the arts).**

Allison and Lawcast teach all the above as noted under the 103(a) rejection and teach interviews, expert commentary, subscriber-client Hyde Park (Lawcast: V: see page 1), but do not disclose advertising programming. This examiner takes the position that it is notoriously old and well known within the content delivery industries (e.g. radio, TV, Internet web sites) to provide advertising programming by sponsors to offset cost of producing and delivering content. For example, Lawcast teaches using legal experts to produce continuing education

content for lawyers. Including advertising programming with the audio tape would be a way to offset cost of content development by charging for paid advertising or bartering for services rendered (i.e. not charging the expert for advertising who contributes content to the service). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Allison to provide advertising programming as taught by Lawcast, in order to encourage experts to provide content.

- 3. Claims 11-14, 16-19, 22, 26, and 27 are rejected under 35 USC 103(a) as being unpatentable over Allison (IDS entered 09 March 2004, US 6,546,230) and Lawcast (a collection of prior art disclosing Lawcast cited in PTO-892, Items: U and V) as applied to claim 1.**

Allison and Lawcast teach all the above as noted under the 103(a) rejection and substantially teach the claimed invention by teaching a system and methods of a) delivering continuing education content and assessment to professionals desiring to keep up to date in their field of practice, b) delivering topical subjects within the fields of science and law that can be delivered online or via portable recording media (i.e. cassette tape), and c) expanding the service due to a myriad of legal specialties to increase growth potential (U: see pages 1 and 2; V: see page 1). One of ordinary skill in the art would ascertain a litany of topics within science and law to help practitioners keep up to date in their respective fields. Therefore it would have been obvious to one of ordinary skill in the art at

time of the invention to modify the system and method of Allison and Lawcast to identify a litany of topics within the fields of science and law as ascertained by one of ordinary skill in the art, in order to expand growth potential of the online service.

Allison and Lawcast teach all the above as noted under the 103(a) and teach accessing course content and updating content, but do not disclose tagging content with an original date. One of ordinary skill in the art at time of the invention would ascertain tagging content with an original date as fundamental as tagging a journal or paper or court case with an original date and retrieving a journal or paper or court case tagged with an original date. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Allison and Lawcast to tag content with an original date as ascertained by one of ordinary skill in the art as being fundamental as tagging a journal or paper or court case with an original date.

- 4. Claim 20 is rejected under 35 USC 103(a) as being unpatentable over Allison (IDS entered 09 March 2004, US 6,546,230) and Lawcast (a collection of prior art disclosing Lawcast cited in PTO-892, Items: U and V) as applied to claims 1 and 19, further in view of ON2 (admitted prior art, Official Notice regarding old and well known in the arts).**

Allison and Lawcast teach all the above as noted under the 103(a) rejection and teach a) searching for topics based on a user-requested topics (Allison) and

b) receiving audio formatted information about patent law (i.e. a specific field of law chosen by the subscriber), but do not specifically disclose selection based on first keyword. The Examiner takes the position that database searches using one or more key words to search a topic is old and well known in the arts. For example, a subscriber entering "patent" as a keyword could receive content titles encompassing content on how to prepare a patent application, how to submit a patent application, how a patent application is prosecuted, etc. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify Allison and Lawcast to implement searches based on at least one keyword as taught by Official Notice, in order to retrieve a variety of content based on at least one keyword.

- 5. Claims 23 and 24 are rejected under 35 USC 103(a) as being unpatentable over Allison (IDS entered 09 March 2004, US 6,546,230) and Lawcast (a collection of prior art disclosing Lawcast cited in PTO-892, Items: U and V) as applied to claim 1.**

Allison teaches a system and method of providing continuing education and learning assessment via an Internet web site (see at least abstract; Fig. 1; col. 1, line 5 through col. 2, lines 42). Allison further teaches:

- an information provider providing an internet web site; (see at least Fig. 1 (24, 80, 84); col.. 2, line1-23; col. 5, lines 14-29).

- said information provider making audio format professional continuing education information available from audio information format machine readable storage via said web site, in topical categories; system provides topical information in audio format (see at least Fig. 8; col. 2, lines 24-42; col. 5, lines 47-52; col. 10, lines 46-50); audio format, either online or via audio tape, CR-ROM, or live broadcast seminar (see at least col. 8, lines 18-22; col. 10, lines 59-67).
- making access to said audio format professional continuing education information available, via said web site to clients by a selection from the group consisting of: periodic subscription; direct pay per access event; access granted on subscription basis, pay-per-use, one time fee (see at least col. 6, lines 54-65).
- said information provider allowing at least one client to receive said audio format professional continuing education information via said web site by, using an internet accessing means, accessing said web site, and providing payment via a selection from the group consisting of: proof of paid subscription; and presenting payment means; Inherent in Allison are the structures necessary to permit providing payment. For example, Allison teaches a network connectivity module being coupled to a license module for verifying subscriber status or pay-per-use access (see at least col. 6, lines 54-65). To become access the system one must have paid.

- and identifying a professional continuing education information topical category of interest, followed by said at least one paying client receiving audio format professional continuing education information in said topical category of interest; user selects course and receives in audio format (see at least Fig. 8; col. 10, lines 46-67).
- attestation: see at least Fig. 5 (182); Fig. 6 (202); Fig. 7 (204); abstract; col. 10, lines 16-45).
- linkage to state licensing body: submits user's transcripts to state licensing entity or other certifying organization(see at least Fig. 9; col. 2, lines 38-42; col. 11, lines 26-33).
- live audio presentation: live broadcast seminar (see at least col. 8, lines 18-22; col. 10, lines 59-67).
- other sources: (see at least col. 5, lines 44-52).
- Overcoming deficiencies: recommends other courses to overcome deficiencies (see at least Fig. 7 (204, 216, 218) and supporting disclosures).
- database storage: stores user profile and records (see at least Fig. 11 (286, 294) and supporting disclosures)

Allison teaches all the above as noted under the 103(a) rejection and teaches
a) providing technological improvements over existing audio tape-based services in delivering continuing education coursework using the Internet and World Wide Web in audio format, b) providing news and recent additions to the site (see at

least Fig. 5), and further teaches the importance of professionals (e.g. medical practitioners) staying up to date in their practice (see at least col. 1, lines 13-17), yet does not disclose updating the audio format in the at least one client identified topical category. On the other hand, Lawcast teaches a system and method of audio format delivery via tape cassettes to legal professionals on the go who want to stay up to date of topics of interest by listening to audio tapes while doing other tasks (e.g. driving a car). Lawcast teaches the subscription-based service providing a 60 to 90-minute tape every two weeks including an outline (i.e. summary) (please note examiner's interpretation: a new tape every two weeks since it doesn't make good business sense to ship the same tape every two weeks to the same individual within the context of staying up to date in the changing legal profession). Lawcast further teaches providing the subscriber with a printed outline that summarizes and cites every case, story, and authority mentioned on tape (U: see at least pages 1 and 2; V: see page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Allison to update the audio format and include case digests and summaries as taught by Lawcast, in order to keep the subscriber up to date in the practice, and thereby attract subscribers to the online service.

Allison and Lawcast teach all the above as noted under the 103(a) rejection and substantially teach the claimed invention by teaching methods that help a professional keep up-to-date via online training with updated course material.

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Although Allison and Lawcast do not disclose offering at least twice, once before and once after information in the topical category is updated, it would have been obvious to one of ordinary skill in the art at time the invention was made to ascertain this to be prudent business practice. For example, one of ordinary skill in the art would ascertain situations or through discovery based on customer complaints, where a user paying based on pay-per-access may take a course immediately before the updated course is posted. Prudent practice would be to offer the updated course either as a customer courtesy or discounted price. If the user is on a subscription-based payment basis, the user can access the updated course again as intended.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 6,170,014 (Darago) 02 January 2001; teaches state of the art in online training and continuing education.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert M. Pond
Primary Examiner
April 15, 2007